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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/578,055	07/27/2006	Richard I. Masel	1201.68586	4911
24978	7590	10/10/2008		
GREER, BURNS & CRAIN 300 S WACKER DR 25TH FLOOR CHICAGO, IL 60606			EXAMINER WILLS, MONIQUE M	
			ART UNIT	PAPER NUMBER
			1795	
			MAIL DATE	DELIVERY MODE
			10/10/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/578,055	Applicant(s) MASEL ET AL.	
	Examiner Monique M. Wills	Art Unit 1795	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>8/3/07 & 10/5/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

The information disclosure statements filed August 3, 2007 and October 5, 2007 has/have been received and complies with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609. Accordingly, the information disclosure statement(s) is/are being considered by the examiner, and an initial copied is attached herewith.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear as to what “ M” refers to. It is unclear as to whether the material a catalyst or electrode material. An appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2 & 7-15, 17-19, 21-26, 27-30 & 32-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hampden-Smith et al. U.S. Pub. 2006/0292434.

With respect to claims 1 & 21, Hampden-Smith teaches a fuel cell comprising:

an anode to which said fluid fuel is directed, said anode having an electrocatalyst

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associated therewith, said electrocatalyst comprising palladium nanoparticles; a cathode to which said fluid oxidant is directed, said cathode electrically connected to said anode; and an electrolyte interposed between said anode and said cathode. See Paragraphs 6 & 102. With respect to claims 1 & 16, 100% formic acid may be used (par. 6). With respect to claims 6, 7 & 27-29, the catalyst is Pd nanoparticles on a carbon support. See paragraphs 108-109 & 102. With respect to claims 8-9, the palladium catalyst nanoparticles have a diameter of 1 to 10 nm. See paragraph 102. With respect to claim 22, the fuel cell includes a proton-conducting membrane having opposing first and second surfaces; a cathode catalyst on the second membrane surface and an anode catalyst including Pd on the first surface. See Paragraphs 6 & 102 and See figure 1. With respect to claim 23, the electrolyte is an ion exchange membrane such as a proton exchange membrane. See paragraphs 6 & 93. With respect to claim 24, the proton exchange membrane comprises a perfluorosulfonic acid ionomer (par. 93). With respect to claims 2, 16, 25 & 31, the catalyst may include Pd, Cr, Mo, W, Nb, B, Sr, Au and Hf. See paragraph 109-110. With respect to claim

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10, the chloride reduction process, is a process limitation in a product claim. The limitation has been considered but has not been given patentable weight. “ [E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” In re Thorpe, 777

F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). With respect to claim 26, the catalyst is Au. See paragraph 110. With respect to claims 33-34, the catalyst is directly adjacent an electrically conductive nickel mesh. See paragraph 380.

Hampden-Smith does not expressly disclose: formic acid fuel (claims 1, 21 & 22); 10% to 45% formic acid (claims 17-29, 21 & 32); the specific weight percents and dispersion of palladium in the catalyst (claims 11-15 & 30).

However, it would have been obvious to one of ordinary skill in the art at the time the instant invention was made to employ formic acid in the fuel cell of Hampden-Smith as the disclosure teaches the conventionality of formic acid fuel in liquid fueled fuel cells. See paragraph 6. See *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960) (selection of a known plastic to make a container of a type made of plastics prior to the invention was held to be obvious).

With respect to claims 11-15 & 30, it would have been obvious to one of ordinary skill in the art at the time the instant invention was made to employ the instant palladium weight and dispersion percents , since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). The skilled artisan recognizes that the concentration of palladium directly effects reaction speed in the cell.

With respect to claims 17-29, 21 & 32, it would have been obvious to one of ordinary skill in the art at the time the instant invention was made to employ the formic acid concentration of 25% to 65% , since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). The skilled artisan recognizes that the concentration of fuel directly effects utilization of the catalyst material.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hampden-Smith et al. U.S. Pub. 2006/0292434 in view of Lawrence et al. U.S. Pub. 2002/0197522.

Hampden-Smith teaches a fuel cell as described in the rejection recited hereinabove. However, the reference does not expressly disclose a replaceable fuel cartridge.

However, Lawrence teaches that it is well known in the art to employ fuel cartridges. See the Abstract.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the instant invention was made to employ the fuel cartridge of Lawrence in the fuel cell of Hampden-Smith, in order to power portable electronic devices.

Conclusion